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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/801,825	03/17/2004	Dean P. Swoboda	2734.411-02	2991

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EXAMINER	
RAYFORD, SANDRA M	

ART UNIT	PAPER NUMBER
1772	

DATE MAILED: 05/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/801,825	SWOBODA ET AL.	
	Examiner	Art Unit	
	Sandra M. Nolan-Rayford	1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *31 January 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *149-313* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *149-313* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *1-31-05*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☒ Other: *PALM inventor listing*.

DETAILED ACTION

Claims

1. Claims 149-313 are pending.

Withdrawal of Allowability

2. The allowability of claim 204 is withdrawn in order to make the new rejection(s) below.

Terminal Disclaimer

3. The terminal disclaimer submitted on 31 January 2005 is sufficient to overcome the double patenting rejection set out in the last office action.

Drawing Objections

4. The application contains many drawings that do not have figure numbers. The drawings must be resubmitted with numbers assigned to each figure.

Objection to Specification

5. The specification is objected to for not describing all of the drawings. It must be revised to add a description of each of the drawings (re)numbered in the response to the drawing objection above.

New Rejections

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 195-202 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

There is no antecedent basis for the phrase "the textured surface coating" in claim 195. See section d of that claim.

Correction is required.

Claim Rejections - 35 USC § 102/103

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 and 103 (a) that are the bases for the rejection(s) below:

Under 102(e):

> A person shall be entitled to a patent unless – ...
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Under 103(a):

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. Claims 149-313 are rejected under 35 U.S.C. 102(e)/103(a) as being anticipated by/unpatentable over Sandstrom et al (US 6,379,497).

Sandstrom has a different inventive entity from that of the instant application. See the enclosed PALM inventor listing for SN. 10/801,825.

Sandstrom teaches paperboard containing cellulose fiber and microspheres (col. 10, lines 50-57; col. 21, lines 33-50) and its use to make various containers for foods (col. 1, lines 11-16). The amounts of microspheres is said to be shown in Figures 31A through 31E (see col. 32, lines 7-14). Figures 31A through 31E show microsphere contents exceeding 57%. The use of binders and pigments id taught at col. 18, lines 12-35. The paperboard is dried and heated to expand the microspheres (col. 37, lines 37-45). The paperboard has buik-enhanced properties (abstract).

Sandstrom does not teach all of the properties recited in applicants' claims.

It would have been obvious to one having ordinary skill in the art at the time of the invention to use suitable amounts of coatings and coating agents in the paperboards of Sandstrom and to use them to make containers for foods are deemed obvious matter of engineering choice, depending upon the properties desired in the food containers.

The motivation to use Sandstrom's paperboards in containers is found at col. 1, lines 11-16 of the patent.

It is deemed desirable to make containers from the paperboards of Sandstrom because the bulk-enhanced properties of same make them more attractive to consumers than thin paper containers.

The properties recited in applicants' claims that are not recited in Sandstrom would be inherent/latent properties of the Sandstrom containers because the same types and amounts of ingredients and processing steps are used to make them.

Statutory Double Patenting

11. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

12. Claim 172 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 1 of prior U.S. Patent No. 6,740,373 (to Swoboda et al). This is a double patenting rejection.

The subject matter in claim 172 of this case and claim 1 of the '373 patent is the same.

Non-statutory Double Patenting

13. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double

patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

14. Claims 149-313 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of U.S. Patent No. 6,740,373. Although the conflicting claims are not identical, they are not patentably distinct from each other because the ingredients and processing steps are the same in the patent's claims and in the instant claims.

The '373 patent and this application share at least one inventor.

The discovery of "new" latent properties in the paperboards, articles and/or containers claimed in the '373 patent does not render the claims of this case patentable over those of the '373 patent.

15. Claims 149-313 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 7-40 of copending Application No. 10/236,347 (as represented by the claims published in US 2003/0152724A1). Although the conflicting claims are not identical, they are not patentably distinct from each other because the ingredients and processing steps are the same in the patent's claims and in the instant claims.

This is a provisional obviousness-type double patenting rejection.

The '347 application and this application share at least one inventor.

The discovery of "new" latent properties in the paperboards, articles and/or containers claimed in the '347 application does not render the claims of this case patentable over those of the '347 application.

Conclusion

Any inquiry concerning this communication should be addressed to Sandra M. Nolan-Rayford, at telephone number 571/272-1495. She can be reached Monday through Thursday, from 6:30 am to 4:00 pm, ET.

If attempts to reach the examiner are unsuccessful, contact her supervisor, Harold Pyon, at 571/272-1498.

The fax number for patent application documents is 703/872-9306.

S. M. Nolan-Rayford
Primary Examiner
Technology Center 1700

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